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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/092,832	03/07/2002	Carl R. Strathmeyer	024/3X6	2647

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EXAMINER

QURESHI, AFSAR M

ART UNIT	PAPER NUMBER
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2667

DATE MAILED: 11/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/092,832

Applicant(s)

STRATHMEYER ET AL.

Examiner

Afsar M Qureshi

Art Unit

2667

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 March 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8. 6) ☐ Other: _____

DETAILED ACTION

Double Patenting

1. Claims 1-5 and 10-21 of this application conflict with claims 1-5 and 10-21 of Application No. 10/145,998. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application.

Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-5, 10-21 are provisionally rejected under the judicially created doctrine of double patenting over claims 1-5, 10-21 of copending Application No. 10/145,998.

This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over copending application 10/145,998 and ROSENBERG J. et al. (XP-000870630) in view of SCHULZRINNE et al. (XP-002242382).

Claims 1-10. ROSENBERG J. et al. ('ROSENBERG' hereinafter) disclose a system comprising an SIP *proxy server*, a *first table* of address translation and registration (Domain Name Service, DNS) and *plural terminals* capable of participating in a

telephone call over a *packet switching data network*. Redirect servers for company.com (pass through server) are connected to data network contain database entry (*second table* that mirrors first table). The redirect servers redirect the proxy. Data network utilizes TCP/IP wherein multiple SIP sessions are contained in a single TCP/IP (claims 6, 7). The local proxy looks up in DNS and obtains the IP address of its SIP server and sends proxy request (fake request) to server handling SIP requests (see page 43, fig. 1) (*claims 1, 2 and 10*).

ROSENBERG further discloses service logic for SIP (see figure 2) that can be an integral part of the server or in special computers connected to server. The service logic controls calls and exchange information with redirect servers (see page 44, under the heading '*Program location*'). As can be seen from figure 1, proxy server and redirect server are resident on the same hardware platform (*claim 3*). The proxy server is arranged to receive an INVITE request for some user (*claim 4*), which is then forwarded to a local SIP proxy server, which in turn looks up in DNS and forwards information to local database, the user accepts the call and response is returned (*claims 5 and 6*).

ROSENBERG does not specifically disclose software to determine whether a particular call is authorized prior to completing a particular. However, SCHULZRINNE et al. ('SCHULZRINNE' hereinafter), in the same field of endeavor, disclose a method for authentication to ensure the accuracy of the information contained in the session setup request call (*claim 8*). (see page 137, under the heading '*SECURITY*').

As one a skilled artisan would readily understand that SIP makes minimal assumptions about the underlying transport protocol. It can directly use any datagram or

stream protocol. SIP can thus be used with UDP or TCP in the Internet and with X.25 (*claim 7*).

As to *claim 9*, SCHULZRINNE discloses '*Multiparty Sessions*' on page 138 where SIP session can use three different multiparty conferencing architecture.

Therefore it would have been obvious to one of ordinary skill in the art, at the time of invention, to be able to utilize authentication mechanism of SCHULZRINNE and modify the typical SIP transaction of ROSENBERG in order to secure against eavesdropping and to protect the registered users from malicious alteration.

Claims 11-14. ROSENBERG discloses creating an INVITE message for user and forwarded to SIP proxy server (*claim 12*). Also, that the calling terminals register with proxy server using 'SIP register' message (*claim 11*). Translating a virtual number to an actual number corresponding to a called terminal, DNS directory, (*claim 13*) is discussed in the rejection of *claim 4*. Pass through server communicates with CTI applications computer, e.g., university.edu and other SIP proxy for cs.university.edu or user agent server (*claim 14*) (see page 43, under the heading '*Signaling Protocol*', figure 1).

Claims 15-16. As discussed in the rejection of *claim 1* above, ROSENBERG discloses a *location server* to route requests, monitor or control a call. This logical entity is further explained by SCHULZRINNE on page 137 (see '*Locating Users*').

As for *claim 16*, ROSENBERG discloses that signaling protocols are used to *tear down sessions* by sending a BYE request.

Claims 17-21. All the limitations claimed herein, such as authentication (see rejection of claim 8); multiparty conference (see rejection of claim 9) and TCP/IP session are already discussed.

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


Mirashrafi et al. (US 6,026,087); (US 6,212,192) and (US 6,199,096)

SCHULZRINNE et al. (W00/76158 A1)

Girard (US 2001/00361176)

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Afsar M Qureshi whose telephone number is (703) 308 8542. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chi Pham can be reached on (703) 305 4378. The fax phone number for the organization where this application or proceeding is assigned is (703) 872 9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305 2381


AFSAR QURESHI
PATENT EXAMINER

November 25, 2003